



7-15-02

Gp/3602
5014

3622

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Sprogis

GROUP: 3602

SERIAL NO: 09/627,870

EXAMINER: Gravini, S.

FILED: July 28, 2000

FOR: SYSTEM AND METHOD FOR DIGITALLY
PROVIDING AND DISPLAYING ADVERTISEMENT
INFORMATION TO CINEMAS AND THEATRES

Box DAC (Petitions to Make Special)
Assistant Commissioner of Patents
Washington, D.C. 20231

RECEIVED
JUL 22 2002
GROUP 3600

PETITION TO MAKE SPECIAL BECAUSE OF ACTUAL INFRINGEMENT
PURSUANT TO 37 C.F.R. §1.102(d) and M.P.E.P. §708.02 II

Applicant hereby petitions to make this application special because of actual infringement.

Accompanying this petition are:

- 1) A Statement of Facts in Support of the Petition to Make Special Because of Actual Infringement;
- 2) A Statement of Opinion of Infringement in Support of the Petition to Make Special Because of Actual Infringement; and
- 3) A check for \$ 130.00 for the Petition fee.

Authorization is hereby given to charge deposit Account No, 19-0079 for any further charges that are required in connection with this Petition to Make Special.

Respectfully submitted,

William E. Hilton
Registration No. 35,192
Samuels, Gauthier & Stevens
225 Franklin Street, Suite 3300
Boston, Massachusetts 02110
Telephone: (617) 426-9180
Extension 111



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

5014
#5
7.2302

APPLICANT: Sprogis **GROUP:** 3602
SERIAL NO: 09/627,870 **EXAMINER:** Gravini, S.
FILED: July 28, 2000
FOR: SYSTEM AND METHOD FOR DIGITALLY
PROVIDING AND DISPLAYING ADVERTISEMENT
INFORMATION TO CINEMAS AND THEATRES

Box DAC (Petitions to Make Special)
Assistant Commissioner of Patents
Washington, D.C. 20231

RECEIVED
JUL 22 2002
GROUP 3600

STATEMENT OF OPINION OF INFRINGEMENT IN SUPPORT OF
PETITION TO MAKE SPECIAL BECAUSE OF ACTUAL INFRINGEMENT
PURSUANT TO 37 C.F.R. §1.102(d) and M.P.E.P. §708.02 II

I, William E. Hilton (PTO Reg. No. 35,192) of Samuels, Gauthier & Stevens, 225
Franklin Street, Suite 3300, Boston, Massachusetts, hereby state as follows.

1. I am an appointed attorney authorized to represent the applicant before the U.S.
Patent and Trademark Office in connection with the prosecution of the above referenced
application.

2. I have made a rigid comparison of the infringing DTDS product of NCN, Inc.
referred in the accompanying Statement of Facts with the claims of this application.

07/18/2002 RMEBRAHT 00000046 09627870

01 FC:122

130.00 DP

O/K

3. In my opinion, at least claims 1, 2, 4, 6, 7, 15, 17, 22, 25 and 26 on file in this application are unquestionably infringed by the infringing DTDS product. More claims may also be infringed depending on whether the DTDS product includes additional features not disclosed in the literature that is attached to the accompanying Statement of Facts. A copy of an analysis of these claims in connection with the DTDS product is attached hereto.

4. A search of the pertinent prior art has been conducted and all such material prior art was provided to the Examiner in an Information Disclosure Statement with the application as filed on July 28, 2000.

5. No office action has yet issued in connection with this application and applicant understands from a representative of Art Group 3602 that it may be another 11 months before a first office action is issued.

6. I believe that each of the claims in this application as on file is allowable.

Respectfully submitted,



William E. Hilton
Registration No. 35,192
Samuels, Gauthier & Stevens
225 Franklin Street, Suite 3300
Boston, Massachusetts 02110
Telephone: (617) 426-9180
Extension 111

Comparison of claims to alleged infringing product

| Claim 1 | DTDS Product of NCN, Inc. |
|---|---|
| A system for communicating with, and providing data representative of advertisement information to, movie projection equipment in theatres, said system comprising: | Yes The DTDS system provides advertisement information to movie projection equipment in theatres. See the Statement of Facts, ¶3, ¶4, Exhibit D |
| a computer storage unit for receiving and storing data representative of advertisement information; | Yes The DTDS system includes a computer storage unit that communicates with its servers. See the Statement of Facts, ¶5, Exhibit D |
| a plurality of digital projector assemblies coupled to said computer storage unit for receiving data from said computer storage unit; | Yes The DTDS system delivers digital content to digital projectors at movie theatres. See the Statement of Facts, ¶6, Exhibit D |
| a movie identification input unit for receiving information regarding a movie that is to be shown in a theatre environment associated with a first of said plurality of digital projector assemblies; and | Yes The DTDS system enables advertisers to target audiences on specific movie screens. See the Statement of Facts, ¶7, Exhibit D |
| a controller for selecting certain stored data for transmission to said first digital projector assembly responsive to said movie identification input unit | Yes The DTDS system includes servers that manage and distribute the digital data. See the Statement of Facts, ¶8, Exhibit D |

| Claim 2 | DTDS Product of NCN, Inc. |
|---|--|
| A system as claimed in claim 1, wherein said first of said plurality of digital projector assemblies includes a computer processing unit in communication with a digital projector. | Yes The DTDS digital projectors are operated by computer processors. See the Statement of Facts, ¶6, Exhibit D |

| Claim 4 | DTDS Product of NCN, Inc. |
|---|--|
| A system as claimed in claim 3, wherein said controller for selecting certain stored data for transmission to said first digital projector assembly is further responsive to the information regarding the assigned time. | Yes The DTDS system enables advertisers to target audiences on specific movie screens. See the Statement of Facts, ¶7, Exhibit D |

| Claim 6 | DTDS Product of NCN, Inc. |
|---|--|
| A system as claimed in claim 5, wherein said controller for selecting certain stored data for transmission to said first digital projector assembly is further responsive to the information regarding the assigned location. | Yes The DTDS system enables advertisers to target audiences on specific movie screens. See the Statement of Facts, ¶7, Exhibit D |

| Claim 7 | DTDS Product of NCN, Inc. |
|---|--|
| A system as claimed in claim 1, wherein said system further includes a network coupled to said computer storage unit and to said plurality of digital projector assemblies. | Yes The DTDS system includes networked digital video servers that are controlled remotely via satellite. See the Statement of Facts, ¶9, Exhibit D |

| Claim 15 | DTDS Product of NCN, Inc. |
|--|---|
| A method of providing data representative of advertisement information to movie projection equipment in theatres, said system comprising the steps of: | <p style="text-align: center;">Yes</p> <p>The DTDS system provides advertisement information to movie projection equipment in theatres.</p> <p>See the Statement of Facts, ¶4, Exhibit D</p> |
| initializing a computer storage unit for receiving and storing data representative of advertisement information; | <p style="text-align: center;">Yes</p> <p>The DTDS system includes a computer storage unit that is initialized and receives and stores data representative of advertisement information.</p> <p>See the Statement of Facts, ¶5, Exhibit D</p> |
| receiving data from the computer storage unit at a plurality of digital projector assemblies; | <p style="text-align: center;">Yes</p> <p>The DTDS system delivers digital content to digital projectors at movie theatres.</p> <p>See the Statement of Facts, ¶6, Exhibit D</p> |
| generating movie identification information regarding a movie that is to be shown in a theatre environment associated with a first of the plurality of digital projector assemblies; and | <p style="text-align: center;">Yes</p> <p>The DTDS system enables advertisers to target audiences on specific movie screens.</p> <p>See the Statement of Facts, ¶7, Exhibit D</p> |
| selecting certain stored data from the computer storage unit for transmission to the first digital projector assembly responsive to the movie identification information. | <p style="text-align: center;">Yes</p> <p>The DTDS system enables advertisers to target audiences on specific movie screens.</p> <p>See the Statement of Facts, ¶7, Exhibit D</p> |

| Claim 17 | DTDS Product of NCN, Inc. |
|--|---|
| A system for providing advertisement information to an audience, said system comprising: | Yes The DTDS system provides advertisement information to movie projection equipment in theatres. See the Statement of Facts, ¶4, Exhibit D |
| storage means for receiving and storing advertisement information regarding a plurality of advertisements; | Yes The DTDS system includes a computer storage unit that communicates with its servers. See the Statement of Facts, ¶5, ¶6, Exhibit D |
| common interest identification means for identifying a characteristic that each of the members of a first audience has in common, and for producing common interest information; | Yes The DTDS system enables advertisers to target audiences on specific movie screens. See the Statement of Facts, ¶7, Exhibit D |
| selection means for selecting a subset of the advertisement information responsive to the common interest information; and | Yes The DTDS system enables advertisers to target audiences on specific movie screens. See the Statement of Facts, ¶7, Exhibit D |
| display means for permitting the selected subset of the advertisement information to be displayed to the first audience. | Yes The DTDS system causes the selected advertisements to be displayed at theatres by the digital projectors. See the Statement of Facts, ¶6, Exhibit D |

| Claim 22 | DTDS Product of NCN, Inc. |
|---|--|
| A system as claimed in claim 17, wherein said common interest information includes information regarding a movie. | Yes The DTDS system enables advertisers to target audiences on specific movie screens. See the Statement of Facts, ¶7, Exhibit D |

| Claim 25 | DTDS Product of NCN, Inc. |
|---|---|
| A method of providing advertisement information to an audience, said method comprising the steps of: | Yes The DTDS system provides advertisement information to movie projection equipment in theatres. See the Statement of Facts, ¶4, Exhibit D |
| providing a storage medium for storing advertisement information regarding a plurality of advertisements; | Yes The DTDS system includes a computer storage unit that communicates with its servers. See the Statement of Facts, ¶5, Exhibit D |
| identifying a common interest characteristic that each of the members of a first audience has in common; | Yes The DTDS system enables advertisers to target audiences on specific movie screens. See the Statement of Facts, ¶7, Exhibit D |
| generating common interest data representative of said common interest characteristic; and | Yes The DTDS system enables advertisers to target audiences on specific movie screens. See the Statement of Facts, ¶7, Exhibit D |
| selecting a subset of the advertisement information responsive to the common interest data. | Yes The DTDS system enables advertisers to target audiences on specific movie screens. See the Statement of Facts, ¶7, Exhibit D |

| Claim 26 | DTDS Product of NCN, Inc. |
|--|---|
| A method as claimed in claim 25, wherein said method further includes the step of displaying the selected subset of the advertisement information to the first audience. | Yes The DTDS system causes the selected advertisements to be displayed at theatres by the digital projectors. See the Statement of Facts, ¶6, Exhibit D |

| | | | |
|-------------------|--|------------------|-------------|
| APPLICANT: | Sprogis | GROUP: | 3602 |
| SERIAL NO: | 09/627,870 | EXAMINER: | Gravini, S. |
| FILED: | July 28, 2000 | | |
| FOR: | SYSTEM AND METHOD FOR DIGITALLY PROVIDING AND DISPLAYING ADVERTISEMENT INFORMATION TO CINEMAS AND THEATRES | | |

STATEMENT OF FACTS IN SUPPORT OF
PETITION TO MAKE SPECIAL BECAUSE OF ACTUAL INFRINGEMENT
PURSUANT TO 37 C.F.R. §1.102(d) and M.P.E.P. §708.02 II

I, David H Sprogis, of 36 Chester Street, Watertown, Massachusetts. hereby state as follows.

1. I am the sole inventor of the subject matter of the above referenced patent application, which claims priority to U.S. Provisional Application Ser. No. 60/148,807 filed August 13, 1999.

2. There is an actual infringement of this invention by NCN, Inc. of Alexandria Virginia (See attached Exhibits A and B which show website information available at www.ncninc.com).

3. NCN, Inc. offers for sale a product called DTDS and/or offers for sale the service of using the product called DTDS (See attached Exhibits C and D).

4. The DTDS product provides advertisement information to movie projection equipment in theatres. See Exhibit D.

5. The DTDS system includes a computer storage unit that, once initialized, receives data and communicates with its servers. See Exhibit D.

6. The DTDS system delivers digital content to digital projectors at movie theatres, and the digital projectors are controlled by computer processors. See Exhibit D.

7. The DTDS system enables advertisers to target audiences on specific movie screens. See Exhibit D.

8. The DTDS system includes servers that manage and distribute the digital data. See Exhibit D.

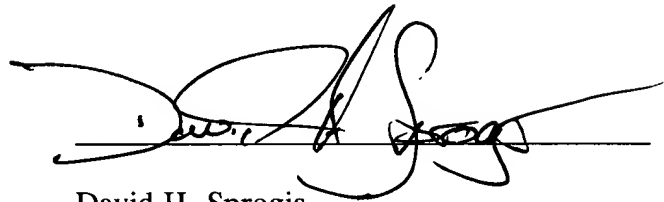
9. The DTDS system includes networked digital video servers that are controlled remotely via satellite. See Exhibit D.

10. The DTDS product was first discovered to be commercially available in about September 2000.


Respectfully submitted,

Date:

7/12/02

A handwritten signature in black ink, appearing to read 'David H. Sprogis', written over a horizontal line.

David H. Sprogis
36 Chester Street
Watertown, MA 02472



NATIONAL CINEMA NETWORK


PRODUCTS

THE CINEMA ADVANTAGE

ADVERTISERS


THE NCN ADVANTAGE

REACHING MOVIEGOERS EVERYWHERE THEY GO



CONTACT US | SITE MAP | ONLINE SURVEY

Online with NCN



Reach moviegoers online!
Your brand will make a splash when it's displayed on NCN's unique network of movie-related sites.

[Click here for more](#)

This site requires a web browser that supports cookies and java and is best viewed with 24bit color.


[Glossary of Design Terms](#)
[Client Slide of the Week](#)
www.NCNinc.com
NationalCinema.net
[Hollywood News](#)

[Home Page](#)
[Products](#)
[Production Specs](#)
[FAQ's](#)
[Image Gallery](#)
[DTDS Video Stream](#)
[Sample Pre-Show Ads](#)
[Sample Slide Show](#)
[NCN Slide Archive](#)
[NCN Customer Listing](#)
[Job Opportunities](#)
[Contact NCN](#)
[NCN Administration](#)

Contact NCN Professional Support

Washington, DC Production Studio

National Cinema Network
 4900 Seminary Road, Suite 1110
 Alexandria, Virginia 22311
 c/o Production Administration
 (703) 379-8570 - fax

Address and
 Fax Numbers:

Kansas City Production Studio
 National Cinema Network
 1300 E. 104th Street, Suite 100
 Kansas City, Missouri 64131
 c/o Production Administration
 (816) 941-8219 - fax

Hours:
Washington, DC Production Studio
 9 am - 5:30 pm (M - F) EST

Kansas City Production Studio
 8:30 am - 5 pm (M - F) CST

Email Support:
NCNads@ncninc.com
 Washington, DC Production Studio
KCdigital@ncninc.com
 Kansas City Production Studio

Resource Center:
[Frequently Asked Questions](#)
[Glossary of Terms](#)



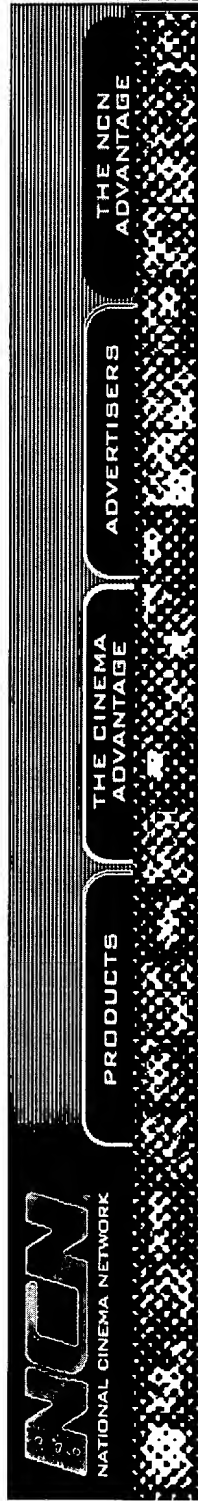
Product Specifications

Send a File to NCN:

NCN FTP Upload Center

For sales information regarding NCN media, please visit: www.NCNinc.com

©2001 NCN. All Rights Reserved.



The NCN Advantage

When it comes to cinema advertising, NCN is the only choice for premier products and service. NCN pioneered the North American cinema advertising industry, successfully introducing ground-breaking media and promotions in movie theatres while respecting and maintaining the entertaining environment.

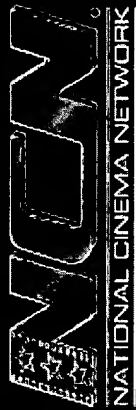
Innovative, Effective Products

Since its inception in 1985, NCN has been committed to creating effective, top-quality cinema media. Its integrated product line, Cinema Media Solutions, includes film (rolling stock), slides, audio, signage, promotional packages and Internet opportunities, reaching moviegoers everywhere they go.

NCN is the only cinema advertising company providing advertisers the ability to reinforce their in-theatre campaigns with an online presence.

NCN continues its commitment to innovation and quality with the introduction of a digital management system, DTDS™. It's an easy-to-use tool to manage content displayed within a movie theatre.

Superior Service



Reaching Moviegoers Everywhere They Go

ncninc.com

Complete our short survey for a chance to win a gift from NCN

At NCN, the spotlight is on you and your ad. NCN has a team of experienced, service-oriented professionals working for you, from your dedicated Account Executive and Sales Associate, to skilled production and traffic staff. We're there for you from the concept stage through your big screen debut.

Quality Assurance

NCN backs its products with a quality assurance program - the only one in the cinema advertising industry - to ensure your needs are met.

Premier Theatres

Representing more than 10,000 screens in North America, NCN's network includes top theatres in top markets and exhibitors with above-average attendance. NCN's Pre-Show Countdown® network delivers:

- 94% of its screens in A & B counties
- 77% of the nation's 24+ screen megaplex theatres
- 29% higher attendance per screen than the industry average
- At least one of the three highest grossing theatres in 21 of the top 25 DMAs

NCN's circuit partners include:

Amstar Entertainment
American Multi-Cinema
Bainbridge Cinemas
Carmike Cinemas
CinemaStar Luxury Theatres
Cobb Theatres
Consolidated Amusement

Entertainment Film Works
Georgia Theatre Company
Gulf States Theatres
Kerasotes Theaters
LoneStar Theatres
Mann Theatres
Marcus Theatres
Metropolitan Theatres
Movies Just Right (MJR)
National Amusements Inc.
Pacific Theatres
Resort Theatres of America
SoCal Cinemas
Starplex Theatres
Starship Theatres

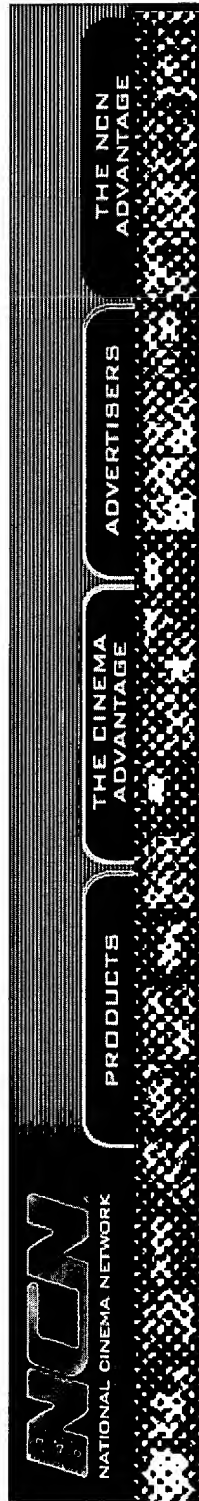
A Solid Reputation

NCN's innovative, high quality cinema media and strong circuit partnerships have attracted market leaders including Nike, BMW, AT&T, Microsoft, and McDonald's - as well as thousands of local and regional advertisers - to include NCN in their advertising and promotion plans.

**You know cinema
advertising is effective.
Buy it from the company
that introduced it.**

For advertising information, call
800.SCREEN.1.

Products • The Cinema Advantage •
Advertisers • The NCN Advantage



DTDS™

While others are talking about it, NCN is delivering digital cinema. Developed by NCN's technical operations team, DTDS™ is made up of networked digital video servers—placed in each theatre, and digital projectors—deployed on all screens in a complex, all controlled remotely from NCN's Network Operations Center in Kansas City. Entertainment and advertising content is beamed and managed via satellite to participating theatres. The servers can manage digital content including live events, distance learning, closed circuit meetings, and ultimately, full-length feature presentation.

DTDS™ is a boon to NCN advertisers and exhibitors. It enables advertisers to target audiences on specific movie screens, as well as digital video monitors, kiosks, plasma screens and other display devices throughout the theatre. For exhibitor partners, DTDS™ provides a reliable, flexible platform that streamlines theatre operations and provides incremental revenue opportunities.

NCN's innovative, high quality cinema media and strong circuit partnerships have persuaded market leaders such as Nike, BMW, AT&T, E-Trade, McDonald's, and Flipside.com to include cinema advertising and promotions in their media plans.



Complete our short survey for a chance to win a gift from NCN



A sample of NCN's digital entertainment
program may be viewed at
www.NCNads.com/DTDS.

For advertising information, call
800.SCREEN.1.
Products • The Cinema Advantage •
Advertisers • The NCN Advantage